

U.S. Serial No. 09/638,570
Response to Office Action dated January 24, 2006
RCE with Amendment dated April 24, 2006

4

REMARKS

Applicants thank the Examiner for the consideration given the present application. Claims 55-79 are pending and Claims 55 and 61-64 are presently amended. Claims 1-54 were cancelled previously. No new claims have been added.

Specifically, Claims 55 and 61-64 have been amended to change the term "onset" to "completion." Support for such amendments can be found in the specification at page 4, lines 33-34, page 10, lines 13-16 and throughout the Examples and specification.

The Rejection under 35 U.S.C. §102

The Examiner has maintained the rejection of Claims 55, 63 and 64 under 35 U.S.C. § 102 as allegedly being anticipated by Jefferson Jr. et al., U.S. Patent No. 5,980,965 (hereafter "Jefferson"). Specifically, the Examiner alleges that Jefferson discloses "a process for preparing a brewed coffee beverage wherein the coffee is brewed in a brewer, stored in the same (in the presence of coffee grounds) for a time including 10 minutes from the onset of brewing, releasing the coffee through a filter after said storage and dispensing same into a coffee receptacle." See Office Action of September 8, 2005, pages 4-5, citing Abstract; Claim 17; Col. 4, lines 53-65. Applicants respectfully traverse this rejection.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim element is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Moreover, it is incumbent on the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990).

Applicants respectfully assert that Jefferson does not anticipate the present invention as under §102 because Jefferson does not teach a process for brewing coffee beverage that involves storing the coffee extract in contact with the grounds for at least about 5 minutes after completion of brewing, as required by the amended claims herein. More particularly, Jefferson is concerned with obtaining a constant brew time for a coffee extract regardless of the volume of coffee extract being prepared in an effort to produce a consistently flavored pot of coffee. Jefferson indicates

U.S. Serial No. 09/638,570
Response to Office Action dated January 24, 2006
RCE with Amendment dated April 24, 2006

5

that "[c]ontact between a portion of the heated water and the coffee grounds is maintained for approximately the selected brew time to form a brewed beverage." See Col. 3, lines 10-12. According to Jefferson, the industry recommended brew time is between about two to four minutes. Col. 1, lines 25-27. Therefore, because the "brew time" must be carefully controlled in order to produce the desired coffee consistency, the brew time of Jefferson must preferably be from two to four minutes. Col. 8, lines 55-56. Additionally, by the end of the brew time, Jefferson teaches that all of the coffee will have exited the brew chamber and have been dispensed into a receptacle. Col. 7, lines 40-50. Thus, within two to four minutes, all of the heated water will have passed through the coffee within the brew chamber to produce an extract, and that extract will have been dispensed into a receptacle.

Applicants respectfully assert that this teaching is contrary to the Examiner's position that Jefferson teaches brewing a coffee extract *and storing* that extract in contact with the grounds for a period of time after completion of brewing, as claimed presently. More specifically, as previously explained, Jefferson teaches that all of the extracted coffee should be dispensed from the brewing chamber by the end of the brew time, which is preferable two to four minutes. Col. 7, lines 35-52. Indeed, Jefferson teaches that "undesirable compounds are normally released into brewed coffee when the hot water remains in contact with the ground coffee beans for relatively long duration." See Col. 1, lines 18-23. This statement supports the notion that Jefferson prevents the brewed coffee extract from being stored in contact with the coffee grounds for any period of time after the completion of brewing, as such contact, according to Jefferson, would result in the release of undesirable compounds into the extract. Therefore, because Jefferson fails to teach storing the brewed coffee extract in contact with the grounds for at least 5 minutes after completion of brewing, Applicants respectfully assert that Jefferson does not anticipate the present invention under §102.

The Rejection under 35 U.S.C. § 103

The Examiner has rejected Claims 56-79 under 35 U.S.C. § 103 as being unpatentable over several references. In general, the Examiner relies on Jefferson alone and taken together with Anson, U.S. Patent No. 5584229 (herein "Anson"), with Cheng, U.S. Patent No. 6,319,537 (herein "Cheng"), Kino et al., U.S. Patent No. 6,231,907 (herein "Kino"), Borland et al., U.S. Patent 6,352,736 (herein "Borland") and GB 2111377 (herein "GB"), to obviate the present claims.

More specifically, the Examiner relies on Jefferson to generally teach a process for preparing a brewed coffee beverage as previously described. The Examiner admits that "Jefferson is silent

5

U.S. Serial No. 09/638,570
Response to Office Action dated January 24, 2006
RCE with Amendment dated April 24, 2006

6

regarding diluting the coffee extract after filtering but before dispensing." However, Anson is relied on to teach diluting beverages as a way to adjust temperature and thus, the Examiner concludes that it would have been obvious to dilute the coffee of Jefferson to control the temperature of the beverage. The Examiner further relies on Cheng to remedy this deficiency, stating that Cheng teaches diluting a coffee concentrate. Additionally, the Examiner states that although Cheng teaches "packaging a brewed coffee concentrate for up to a large period of time" there is no teaching of diluting 5 minutes to 48 hours after filtering. In spite of this deficiency, the Examiner concludes that this would have been obvious. Based on Kino, it is further concluded that it would have been obvious to store the coffee extract in contact with the grounds sealed from oxygen. Finally, Borland is relied on to teach brew solids content of the coffee extract while GB is relied on to teach filtering after 15 and 30 minutes. Applicants respectfully traverse these rejections.

Applicants respectfully submit that, a reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore and Assoc., Inc. For all of the reasons stated previously in the discussion under § 102, Jefferson teaches away from the present invention. In particular, Jefferson teaches that "undesirable compounds are normally released into brewed coffee when the hot water remains in contact with the ground coffee beans for relatively long duration." See Col. 1, lines 18-23. This statement teaches away from the presently amended claims, which indicate that the coffee extract, which is arguably comprised in part by hot water, should be stored in contact with the coffee grounds for from about 5 minutes to about 48 hours after the completion of brewing the extract." See Claim 55, from which all other claims depend. As Jefferson teaches that "storing" in the manner required by the present claims would result in the release of undesirable compounds into the extract, it is respectfully asserted that Jefferson teaches away from the present invention, and for this reason alone, the present invention is not obviated.

In addition, the Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). Distilling the invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of prima facie obviousness by the appropriate standard. If the Examiner does not prove a prima facie case of unpatentability,

6

U.S. Serial No. 09/638,570
Response to Office Action dated January 24, 2006
RCE with Amendment dated April 24, 2006

7

then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a prima facie case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the cited reference must teach or suggest *all* the claim limitations. See, for example, In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Applicants respectfully assert that the Office Action fails to establish the second and third criteria, and thus, fails to make a prima facie case of obviousness under 35 U.S.C. § 103.

First, there is no likelihood success. For the reasons discussed previously in regards to the teachings of Jefferson, Applicants respectfully assert that Jefferson provides no likelihood of success. Moreover, the additional cited references do nothing to remedy the deficiencies of Jefferson. In particular, none of the cited references teaches storing a brewed coffee extract in contact with coffee grounds for any length of time after the completion of brewing and the Examiner admits as much in the Office Action. See Office Action page 4. Therefore, it is respectfully asserted that Jefferson, both alone and when taken together with the additional references, fails to provide a likelihood of success and thus, for this reason alone, fails to establish a prima facie case of obviousness.

Additionally, there is no teaching of all the claim limitations. Again, none of the references, either alone or in combination, teach storing a brewed coffee extract in contact with coffee grounds after completion of brewing in the first instance, as claimed in the presently amended Claim 55, from which all other claims herein ultimately depend. Indeed, as explained previously, Jefferson actually teaches away from this practice. Because the references fail to teach all of the present claim limitations, Applicants respectfully assert that for this additional reason, a prima facie case of obviousness has not been established.

For these additional reasons, it is respectfully asserted that the present claims are not obvious in view of the cited references, and it is therefore respectfully requested that the rejection under 35 U.S.C. §103 be withdrawn.

7


U.S. Serial No. 09/638,570
Response to Office Action dated January 24, 2006
RCE with Amendment dated April 24, 2006

8

CONCLUSION

In view of the foregoing, it is respectfully submitted that the Examiner's rejections under 35 U.S.C. §§ 102 and 103, as well as the double patenting rejection, have all been overcome. Withdrawal of these rejections is respectfully requested.

Respectfully submitted,

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